

REMARKS

Claims 1-11 and 13-24 were pending in this application. Claims 1, 3-9, 11, 19-21, and 23 were rejected, and claims 2, 10, 13-18, 22, and 24 were objected to. By virtue of this response claims 1-11, 13, and 19-24 are amended. Accordingly, claims 1-11 and 13-24 are now under consideration.

Support for amended claims 1-11, 13, and 19-24 can be found throughout the original application. Claims 1-11, 13, 19, 20, 23, and 24 have been amended to delete the term “derivative”. Claims 1-11 and 22 were amended to clarify the claims. Support for the amendments in claim 21 can be found throughout the original specification, and *inter alia*, at page 28, lines 1-10; page 46, line 7; and page 47, lines 1-2.

No new matter has been added and entry of the amendments is respectfully requested.

The amendments are made solely to promote prosecution without prejudice or disclaimer of any previously claimed subject matter. With respect to all amended claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded subject matter or claim embodiments in one or more future continuation and/or divisional application(s).

Applicants have carefully considered the points raised in the Office Action and believe that the Examiner’s concerns have been addressed as described herein, thereby placing this case into condition for allowance.

Withdrawn Rejections

Claims 1, 3-9, 11, 19, 20 and 23 were previously rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 19 was previously rejected under 35 U.S.C. 112, 2nd paragraph, for allegedly omitting essential steps. Claims 19 and

21 were previously rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants gratefully acknowledge the withdrawal of these rejections.

Maintained and New Rejections

The Office has maintained the rejection of claims 1, 3-9, 11, 19, 20, 23 and 24 under 35 U.S.C. 112, 2nd paragraph, as allegedly being indefinite. The Office newly rejected claims 19 and 21 under 35 U.S.C. 112, first paragraph, as allegedly failing to meet the enablement requirement.

Applicants note that the Office did not withdraw the 35 U.S.C. § 112, first paragraph, written description rejection against claim 24, however, the Office Action does not address this issue further. Applicants assume that the Office meant to withdraw this rejection, and do not address it further herein.

Rejections Under 35 U.S.C. § 112, 1st paragraph:

The Office rejected claims 19 and 21 under 35 U.S.C. 112, first paragraph, as allegedly failing to meet the enablement requirement. The Office asserted that the specification is “enabling for a pharmaceutical composition comprising one or more derivatives according to claim 1, and one or more further compounds selected from excipients, adjuvants and pharmaceutical active ingredients such as appetite suppressants, vitamins, diuretics and antiphlogistics” but “does not reasonably provide enablement for any pharmaceutical active ingredient.” (OA at page 4).

Without acquiescing to the rejection, Applicant has amended claims 19 and 21. Claim 19 no longer refers to a separate pharmaceutically active ingredient. Claim 21 was amended to recite a “further pharmaceutical active ingredient selected from the group consisting of appetite suppressants, vitamins, diuretics, and antiphlogistics,” which the Examiner admitted was enabled. (See page 4 of the April 19, 2007 Office Action). Applicants maintain that pharmaceutical compositions containing other pharmaceutically active ingredients are enabled, but have made this amendment without prejudice or disclaimer, solely to advance prosecution.

In view of the foregoing amendments, Applicants submit that the enablement requirement has been met and request the withdrawal of the rejections.

Rejections Under 35 U.S.C. § 112, 2nd paragraph:

Claims 1, 3-9, 11, 19, 20 and 23 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for reciting the phrase "derivative". The Examiner kindly suggested the rejection would be overcome by deleting the term "derivative". Applicants have taken the Examiner's suggestion, and have deleted this term from the claims. In view of the amendments, Applicants submit that the indefiniteness rejection should be withdrawn.

CONCLUSIONS

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952 referencing docket No. 613242000800**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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